



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/009,008	01/08/2002	Bernard Cuenoud	4-30970A	1967

1095 7590 02/05/2004

THOMAS HOXIE
NOVARTIS, CORPORATE INTELLECTUAL PROPERTY
ONE HEALTH PLAZA 430/2
EAST HANOVER, NJ 07936-1080

EXAMINER

KIFLE, BRUCK

ART UNIT PAPER NUMBER

1624

DATE MAILED: 02/05/2004

12

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Applicati n N .

10/009,008

Applicant(s)

CUENOUD ET AL.

Examin r

Bruck Kifle, Ph.D.

Art Unit

1624

-- The MAILING DATE of this communication appears on the cover sheet with th correspondence address --
Peri d f r ply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 08 October 2003.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 17-40 is/are pending in the application.
- 4a) Of the above claim(s) 18,22,24,25,30 and 37 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 17, 19-21, 23, 26-29, 31-36 and 38-40 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. §§ 119 and 120

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 13) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.
a) ☐ The translation of the foreign language provisional application has been received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ 6) ☐ Other: _____

Art Unit: 1624

Applicant's amendments and remarks filed 10/8/03 have been received and reviewed.

Claims 17-40 are now pending in this application.

Claims 18, 22, 24, 25, 30, 37 along with subject matter not elected of the remaining claims remain withdrawn from consideration. Applicants need to cancel non-elected subject matter.

Claim Rejections - 35 USC § 112

Claims 17, 19-21, 23, 26-29, 31-36 and 38-40 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

- i) In the definitions of the "R" groups, it is not known which and how many hetero atoms interrupt the alkyl groups.
- ii) The term "heterocyclic" is indefinite because it is not known how many atoms make up the ring, which atoms are present and what kind of a ring (monocyclic, bicyclic, spiro, fused, bridged, saturated, etc.) is intended.

Applicants are reminded that although the claims are interpreted in light of the specification, critical limitations from the specification cannot be read into the claims (see, e.g., *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Ded. Cir. 1991)). Accordingly, without the recitation of all these critical limitations, the claims do not adequately define the instant invention.

The U.S. Court of claims held to this standard in *Lockheed Aircraft vs. Unites States*, 193 USPQ 449, "claims measure the invention and resolution of invention must be based on what is claimed."

Art Unit: 1624

The CCPA said, "that invention is the subject matter defined by the claims submitted by the applicant." "We have consistently held that no applicant should have limitations of the specification read into a claim where no express statement of the limitation is included in the claim" (In re Priest, 199 USPQ 11 at 15).

Therefore Applicants need to indicate, in the claim, what is intended.

Claim 33 is rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention.

In evaluating the enablement question, several factors are to be considered. Note In re Wands, 8 USPQ2d 1400 and Ex parte Forman, 230 USPQ 546. The factors include: 1) The nature of the invention, 2) the state of the prior art, 3) the predictability or lack thereof in the art, 4) the amount of direction or guidance present, 5) the presence or absence of working examples, 6) the breadth of the claims, and 7) the quantity of experimentation needed.

1) The nature of the invention: The method of use claim is are drawn in part to prevention and in part to treatment of any and all conditions alleviated by the activation of the β 2-adreno receptor.

2) The state of the prior art: There are no known compounds of similar structure which have been demonstrated to treat and prevent all conditions alleviated by the activation of the β 2-adreno receptor. Is extensive experimentation required on the part of a potential infringer to determine if his use of Applicants' activators falls within the limitations of applicants' claim? *In re Kirk and Petrow*, 153 USPQ 48 (CCPA 1967). As the Supreme Court said in *Brenner v.*

Art Unit: 1624

Manson, 148 USPQ at 696: "a patent is not a hunting license. It is not a reward for the search, but compensation for its successful conclusion." As U.S. Court of Customs and Patent Appeals stated *In re Diedrich* 138 USPQ at 130, quoting with approval from the decision of the board:

"We do not believe that it was the intention of the statutes to require the Patent Office, the courts, or the public to play the sort of guessing game that might be involved if an applicant could satisfy the requirements of the statutes by indicating the usefulness of a claimed compound in terms of possible use so general as to be meaningless and then, after his research or that of his competitors has definitely ascertained an actual use for the compound, adducing evidence intended to show that a particular specific use would have been obvious to men skilled in the particular art to which this use relates."

3) The predictability or lack thereof in the art: It is presumed in the prevention of the conditions embraced by this claim there is a way of identifying those people who may develop any kind of the conditions embraced. There is no evidence of record which would enable the skilled artisan in the identification of the people who have the potential of becoming afflicted with the conditions embraced herein.

4) The amount of direction or guidance present and 5) the presence or absence of working examples: There are no doses present to direct one to protect a potential host from the disorders cited, etc. There are no doses present for treatment of the disorders recited and there is no data present for the prophylaxis of these disorders.

6) The breadth of the claims: The claims are drawn to disorders that are not related and whose prevention is unknown.

Art Unit: 1624


7) The quantity of experimentation need would be an undue burden to one skilled in the pharmaceutical arts since there is inadequate guidance given to the skilled artisan for the many reasons stated above.

Thus, factors such as "sufficient working examples", "the level of skill in the art" and "predictability", etc. have been demonstrated to be sufficiently lacking in the instant case for the instant method claims.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Bruck Kifle, Ph.D. whose telephone number is 703-305-4484. The examiner can normally be reached on 9:30-6:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mukund J. Shah can be reached on 703-308-4716. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-1235.


Bruck Kifle, Ph.D.
Primary Examiner
Art Unit 1624

BK
February 4, 2004